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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/675,398      09/29/00      LLINAS-BRUNET

M      13/068-3-D3

023703      HM22/0417  
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EXAMINER

OSWECKI, J

ART UNIT

PAPER NUMBER

1626

DATE MAILED:

04/17/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/675,398**

Applicant(s)  
**Llinas-Brunet**

Examiner  
**Jane Oswecki**

Group Art Unit  
**1626**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-25, 36-45, 52, 53, 66-75, 80, and 84-87 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 5-7, 11-14, 36, 37, and 45 is/are rejected.

☒ Claim(s) 2-4, 8-10, 15-25, 38-44, 52, 53, 66-75, 80, and 84-87 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 1

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

*Jane Oswecki*  
**JANE C. OSWECKI**  
**PRIMARY EXAMINER**  
*Art Unit 1626*

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

Claims 1-25, 36-45, 52, 53, 66-75, 80, and 84-87 are pending in the application.

#### ***Claim Rejections - 35 USC § 112, Second Paragraph***

The following quotation of 35 U.S.C. 112, second paragraph, forms the basis for all lack of clarity rejections found within this Office action:

“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”

Claims 1, 5-7, 11-14, 36, 37 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has the transitional word “comprising” which is open-ended. Especially with respect to claims for compounds, the word “comprising” renders the claim indistinct (see MPEP 2111.03).

Claims 1, 5-7 and 11-14 are confusing with respect to the definitions for “B” substituents. While a “B” substituent is clearly defined as “...an acyl derivative...”, it is next defined as “...a carboxyl...” where an ester is shown; as “...an amide...” where a carboxamide is shown; as “...a thioamide...”; and as “...a sulfonyl...”. It is suggested that the word “derivative” be inserted after each of these terms in these claims and in all occurrences for purposes of clarity and in keeping with the term “acyl derivative”.

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Claims 36, 37 and 45 are confusing in that claim 1, from which each of these claims ultimately depends, structurally depicts amino acid segments designated as P1, P2 and P3. However, claims 36 and 37 define P1 as a cyclobutyl or cyclopropyl ring, and claim 45 defines P1 as a cyclopropyl ring. This is confusing where the P1 segment in independent claim 1 has amino and carboxyl moieties in addition to the ring structure.

Appropriate correction is required in all instances.

#### ***Provisos***

The proviso to claim 1 are noted. If such are included to bring the claims outside the scope of known prior art, such art should be provided to ensure complete consideration. If the provisos are included to eliminate compounds known to lack the disclosed utility, such should be stated on the record.

#### ***Claim Objections***

Claims 1, 15, 19 and 53 are objected to because of the following informalities: claim 1, last three lines, in the definition of "Het" is objected to for embracing heterocycles that are non-elected under the terms of the Restriction Requirement.

Claims 15 and 19 include parentheticals for terms defined in the specification. The use of parentheses implies that additional or explanatory information is contained therein, while claims are to be written in a clear and concise manner. It is suggested that these parentheticals be deleted from the claims.

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Claim 53 is objected to for listing compounds by compound numbers drawn from a table rather than by nomenclature or structure. It is preferred that compounds and their substituents be listed by nomenclature or structural depiction.

Claims 2-4, 8-10, 15-25, 38-44, 52, 53, 66-75, 80 and 84-87 also are objected to for depending from a rejected base claim.

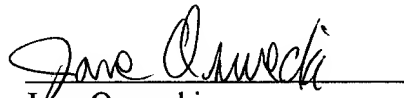
Appropriate correction is required in all instances.

***Telephone Inquiry Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Oswecki whose telephone number is (703)305-7152. The examiner can normally be reached Monday through Thursday from 7:30 AM to 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (703)308-4537. The telephone number for this Group is (703)308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-1235.

  
Jane Oswecki  
Primary Examiner  
Art Unit 1626

13 April 2001